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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

U.S. Appln No.: 10/720,005
(Attorney's Docket No. H-203754)

Filed: November 21, 2003
Confirmation No. 3992

Inventor: Matthew H. Fronk et al

Art Unit: 1795

TITLE: CORROSION RESISTANT
PEM FUEL CELL

Examiner: Tracy Mae Dove

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO NOTICE OF NON-COMPLIANT
APPEAL BRIEF

Sir:

This is Applicants' response to the Notice of Non-Compliant Appeal Brief dated November 7, 2008. The Notice of Non-Compliant Appeal Brief is improper and should be respectfully withdrawn. The administrator's and the Examiner's attention is respectfully directed to MPEP 1454 (copy attached) which indicates for a reissue application, an Appeal Brief should include a copy of the claims including underlining and bracketing necessary to reflect the changes made to the patent claims during prosecution of the reissue application. Applicants have so submitted a claim set, including such underlining and bracketing in a proper manner. Immediate withdrawal of the Notice and entry of the Appeal Brief is respectfully requested.

Dated: November 17, 2008

Respectfully submitted,



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application to show amendments made relative to the first reissued patent

(B) For a reissue application, where the patent was previously reexamined and a reexamination certificate has issued for the patent:

An amendment in the reissue application must be presented as if the changes made to the original patent text via the reexamination certificate are a part of the original patent. Thus, all italicized text of the reexamination certificate is presented in the amendment (made in the reissue application) without italics. Further, any text found in brackets in the reexamination certificate is omitted in the amendment (made in the reissue application).

(C) For a reissue application, where a certificate of correction has issued for the patent:

An amendment in the reissue application must be presented as if the changes made to the original patent text via the certificate of correction are a part of the original patent. Thus, all text added by certificate of correction is presented in the amendment (made in the reissue application) without italics. Further, any text deleted by certificate of correction is entirely omitted in the amendment (made in the reissue application).

(D) For a reissue application, where a statutory disclaimer has issued for the patent:

Any claim statutorily disclaimed is no longer in the patent, and such a claim cannot be amended. The statutorily disclaimed claim(s) should be lined through, and not surrounded by brackets.

1454 Appeal Brief [R-3]

The requirements for an appeal brief are set forth in 37 CFR *41.37< and MPEP § 1206, and they apply to a reissue application in the same manner that they apply to a non-reissue application. There is, however, a difference in practice as to presentation of the copy of the claims in the appeal brief for a reissue application. The claims on appeal presented in an appeal brief for a reissue application should include all underlining and bracketing necessary to reflect the changes made to the patent claims during the prosecution of the reissue application. In addition, any new claims added in the reissue application should be completely underlined.

1455 Allowance and Issue [R-3]

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I. ISSUE CLASSIFICATION SHEET

For IFW reissue applications:

The examiner completes the Issue Classification sheet in the same manner as for a non-reissue application. In addition, a copy of the "Final SPRE Review" form must also be completed.

For reissue application files that are maintained in paper:<

In all reissue applications prepared for issue where a blue slip is needed (i.e., 08/ and earlier series), the patent number of the original patent which is being reissued should be placed in the box provided therefor below the box for the applicant's name on the blue Issue Classification Slip (form PTO-270) or design Issue Classification Slip (form PTO-328). Otherwise, the Issue Classification Slip is prepared in the same manner as for a non-reissue application. **

For 09/ and later series applications, the patent number of the original patent which is being reissued should be placed on the face of the file wrapper above the box "PREPARED AND APPROVED FOR ISSUE" just after "(Exr. Initials)" in the line reading "SURRENDER OF ORIGINAL PATENT _____ (Exr. Initials)." **

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II. < CHANGES TO THE ORIGINAL PATENT

The specifications of reissue patents will be printed in such a manner as to show the changes over the original patent text by enclosing any material omitted by the reissue in heavy brackets [] and printing material added by the reissue in *italics*. 37 CFR 1.173 (see MPEP § 1411) requires the specification of a reissue application to be presented in a specified form, specifically designed to facilitate this different manner of printing, as well as for other reasons.

The printed reissue patent specification will carry the following heading, which will be added by the Publishing Division of the Office of Patent Publication:

"Matter enclosed in heavy brackets [] appears in the original patent but forms no part of this reissue specification; matter printed in italics indicates the additions made by reissue."

The examiners should see that the specification is in proper form for printing. Examiners should care-